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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/248,392	02/12/1999	HUBERTUS ALEXANDER SPAEPEN	GB97/023	8699

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EXAMINER

LISH, PETER J

ART UNIT	PAPER NUMBER
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1754

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/248,392

Applicant(s)

SPAEPEN, HUBERTUS
ALEXANDER

Examiner

Peter J Lish

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: the new claim, claim 23, raises new issues.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-21.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Applicant's arguments have been fully considered but they are not persuasive. The applicants argue that Matthews teaches the use only of "in-line mixers", which would not lead one of ordinary skill to employ "static in-line mixers". The applicant cites Perry's Handbook to show that a variety of in-line mixers exist and thus the use of a particular type of in-line mixer, such as a static in-line mixer, is not inherent. The examiner agrees that it is not inherent, however, upon the reading of "in-line mixer", one of ordinary skill would have necessarily selected a specific type of in-line mixer from among the known types, which include the static in-line mixers (as supported by Perry's Handbook), in order to perform the desired operation.


The discussion of the Azko case (1 USPQ2d 1241, 1425) is of no relation to issues at hand and is considered irrelevant. It is well known that different concentrations of acids, sulfuric acid in the cited case, may produce different effects or perform different operations. Therefore the term 'sulfuric acid' does not simply require the selection of any concentration of sulfuric acid with the expectation that all will achieve the desired effect. Contrastingly, the term 'in-line mixer' simply requires the selection of a type of mixer, as it is expected that all will achieve the desired effect of mixing.

The applicants additionally argue that there is no motivation to use a static in-line mixer as the in-line mixer of Matthews because Perry's teaches that static in-line mixers cause pressure drop. However, while Perry's states that the static in-line mixers produce a pressure drop (it is noted that almost all mixers cause a pressure drop of some magnitude), it also states that the benefits of a static mixer include enhanced heat transfer, uniform residence times, and low power consumption, as the power consumed is simply that delivered to the fluid pump. While each

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type of in-line mixer is expected to have slight benefits and drawbacks, all are expected to perform the operation of mixing, which is the operation desired by Matthews.

The applicants go on to argue the limitations of new claim 23, however, this claim is not entered because the limitations of this claim raise new issues.



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